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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/973,809	10/11/2001	Lisa Palmqvist	024444-975	7897

7590

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Ronald L. Grudziecki
BURNS, DOANE, SWECKER & MATHIS, L.L.P.
P.O. Box 1404
Alexandria, VA 22313-1404

EXAMINER

CHEN, BRET P

ART UNIT

PAPER NUMBER

1762

DATE MAILED: 06/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/973,809

Applicant(s)

Lisa Palmqvist et al.

Examiner

Bret Chen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Mar 31, 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-20 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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DETAILED ACTION

Claims 11-20 are pending in this application

The amendment dated 3/31/03 has been entered and carefully considered. The examiner appreciates the amendments to the abstract, title, and specification. In view of said amendment, the objection to the abstract, title, and art rejection have been withdrawn.

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 11-20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 9 of U.S. Patent No. 6,326,093 for the reasons listed in the previous office action.

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Response to Arguments

2. Applicant's arguments filed 3/31/03 have been fully considered but they are not persuasive.

Applicant first argues that there are numerous differences between Lindholm and the claimed invention (pp.5-6).

The examiner disagrees. It is noted that the patented claim 9 recites:

A method of making a cutting tool, the method comprising:
forming a powder mixture containing WC, Co and cubic carbides;
mixing said powders with pressing agent and W metal such that the desired CW-ratio is obtained;
milling and spray drying the mixture to a powder material with the desired properties;
pressing and sintering the powder material at a temperature of 1300-1500.degree. C., in a controlled atmosphere of about 50-mbar followed by cooling to form a substrate; and
applying a hard, wear resistant coating by PVD techniques comprising:
depositing a first innermost bonding layer of TiN;
depositing a second layer comprising a 0.05-0.2 .mu.m thick multilayered structure of sublayers of the composition (Ti.sub.x Al.sub.1-x)N in which x varies repeatedly between the two ranges 0.45<x<0.55 and 0.70<x<0.80, the first sublayer of (Ti.sub.x Al.sub.1-x)N adjacent to the TiN bonding layer having an x-value in the range 0.45<x<0.55, the second sublayer of (Ti.sub.x Al.sub.1-x)N having an x-value in the range 0.70<x<0.80 and the third sublayer having an x value in the range 0.45<x<0.5, and so forth repeated until 8-30 sublayers are built up;
depositing a third at least 0.2 .mu.m thick layer of (Ti.sub.x Al.sub.1-x)N, where x is in the range 0.45<x<0.55;
depositing a fourth outermost layer of TiN; wherein the total coating thickness is in the range of 2-9 .mu.m and the thickness of the second layer constitutes 75-95 % of the total coating thickness.

The limitation in applicant's claim 11 which recites "a method of making a cutting insert comprising a cemented carbide body" reads on Lindholm's "A method of making a cutting tool ... comprising ...forming a powder mixture containing WC, Co and cubic carbides".

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The limitation of "forming a powder mixture containing WC, ...Co ... of cubic carbides" reads on Lindholm's *forming a powder mixture containing WC, Co and cubic carbides.*"

The limitation of "milling and spray drying the mixture" reads on Lindholm's *"milling and spray drying the mixture"*.

The limitation of "compacting and sintering the powder" reads on Lindholm's *"pressing and sintering the powder material"*.

The limitation of "applying post-sintering treatment; and applying a hard, wear resistant coating" reads on Lindholm's *"cooling to form a substrate; and applying a hard, wear resistant coating"*.

In other words, the applicant's claim, while not identical word for word, is basically the same as that of the cited reference. The only significant difference appears to be the use of the weight percentages which the examiner has deemed an obvious variation.

Applicant's arguments have been considered but are not deemed persuasive.

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR

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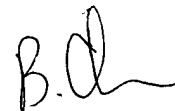
1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bret Chen whose telephone number is (703) 308-3809. The examiner can normally be reached on Monday through Friday from 10:00 am to 7:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive Beck, can be reached on (703) 308-2333. The fax phone number for this Group is (703) 872-9310. Amendment After Finals should be faxed to (703) 872-9311.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

bc
June 15, 2003



BRET CHEN
PRIMARY EXAMINER